

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NANCY C. FRYE
and LARRY L. ULAND

Appeal No. 98-1538
Application 08/698,470¹

ON BRIEF

Before CALVERT, Administrative Patent Judge, McCANDLISH,
Senior Administrative Patent Judge, and MEISTER,
Administrative Patent Judge.

MEISTER, Administrative Patent Judge.

DECISION ON APPEAL

¹ Application for patent filed August 15, 1996. According to appellants, this application is a continuation of Application 08/380,814, filed January 30, 1995, now abandoned.

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Nancy C. Frye and Larry L. Uland (the appellants) appeal from the final rejection of claims 1 and 28-34, the only claims remaining in the application.²

We AFFIRM-IN-PART and, pursuant to our authority under the provisions of 37 CFR § 1.196(b), we will enter new rejections of claims 32-34 under 35 U.S.C. § 112, first and second paragraphs.

The appellants' invention pertains to a shoe comprising a combination reverse wedge and sole for wear below the sole of a wearer's foot. Independent claim 1 is further illustrative of the appealed subject matter and a copy thereof may be found in APPENDIX A of the brief.

The references relied on by the examiner are:

Monier	2,769,252	Nov. 6, 1956
Whitaker	4,217,704	Aug. 19, 1980
Simoglou	4,370,818	Feb. 1, 1983
Fox	5,507,106	Apr. 16, 1996
	(patent filed Jun. 18, 1993)	

² Claims 28, 29 and 34 have been amended subsequent to final rejection by an amendment filed on April 29, 1997 (Paper No. 19). In an advisory action mailed on May 8, 1997 (Paper No. 20) the examiner indicated that the amendment would be entered for purposes of appeal and the "112 objections and rejections" had been overcome. We observe, however, that no clerical entry of this amendment has in fact been made.

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Hackner (EP) 0 083 449³ Dec. 31, 1981
(Hackner)

The answer states that the following rejections are applicable to the claims on appeal:

(1) Claims 1 and 30-32 under 35 U.S.C. § 102(e) as anticipated by Fox;

(2) Claims 1, 32 and 33 under 35 U.S.C. § 103(a) as being unpatentable over Whitaker in view of either Simoglou or Hackner;

(3) Claims 28 and 29 under 35 U.S.C. § 103(a) as being unpatentable over Whitaker in view of either Simoglou or Hackner, and Monier; and

(4) Claims 1, 31, 33 and 34 under 35 U.S.C. § 103(a) as being unpatentable over Whitaker in view of Fox.

The rejections are explained on pages 3-5 of the answer. The arguments of the appellants and examiner in support of their respective positions may be found on pages 4-12 of the brief, pages 1-6 of the reply brief and pages 5-7 of the answer.

³ Translation attached.

OPINION

As a preliminary matter we base our interpretation of the subject matter set forth in independent claim 1 upon the following interpretation of the terminology appearing in the claims. Noting that a "plane" has no thickness, we interpret (a) "the rear plane increasing in thickness forwardly" to be -- the area between the substantially planar upper surface and the rear plane increasing in thickness forwardly -- and (b) "the forward plane remaining substantially constant in thickness" to be -- the area between the substantially planar upper surface and the forward plane remaining substantially constant in thickness --. In line 4 of claim 1, we interpret "for supporting the sole" to be -- for supporting the sole of a wearer's foot --.

Considering first the rejection of claims 1, 30 and 31 under 35 U.S.C. § 102(e) as being anticipated by Fox, the examiner is of the opinion that "Fox shows a shoe with an upper (13), a sole (12) with a rear plane (30) and a forward plane (27)" (Answer, page 3). The appellants, however, argue that:

The forward plane identified by the Examiner is not even a forward plane in the Fox patent but is an

intermediate plane between a first angle portion at the heel and a second angle portion at the toe of the Fox patent. The intermediate plane does not extend to the forward edge of the shoe of the Fox patent. By contrast, the claimed invention requires a forward plane with a substantially constant thickness to its forward edge. The forward plane is specifically defined in Applicants' specification as extending from a rear plane to a forward peripheral edge of the shoe. [Reply brief, page 2.]

We are unpersuaded by the appellants' arguments. The terminology in a pending application's claims is to be given its broadest reasonable interpretation (*In re Morris*, 127 F.3d 1048, 1056, 44 USPQ2d 1023, 1028 (Fed. Cir. 1997) and *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d, 1320, 1322 (Fed. Cir. 1989)) and limitations from a pending application's specification will not be read into the claims (*Sjolund v. Musland*, 847 F.2d 1573, 1581-82, 6 USPQ2d 2020, 2027 (Fed. Cir. 1988)). Moreover, anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or the recognition of inherent properties that may be possessed by the prior art reference. *See Verdegaa1 Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir. 1987). A prior art reference anticipates the subject matter of a claim when that reference

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discloses every feature of the claimed invention, either explicitly or inherently (*see In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) and *Hazani v. Int'l Trade Comm'n*, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997)); however, the law of anticipation does not require that the reference teach what the appellant is claiming, but only that the claims on appeal "read on" something disclosed in the reference (*see Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), *cert denied*, 465 U.S. 1026 (1984)).

Here, while claim 1 broadly recites a "forward" plane, there is simply no claim limitation which requires the forward plane to extend to the forward edge of the shoe as argued.⁴ This being the case, we agree with the examiner that plane 27 of Fox can be considered to be a "forward" plane as broadly claimed since this plane is clearly "forward" of rear plane 30. As to the appellants' contention that the forward plane is "specifically defined" in the specification as "extending

⁴ It is well settled that features not claimed may not be relied upon in support of patentability. *In re Self*, 671 F.2d 1344, 1348, 213 USPQ 1, 5 (CCPA 1982).

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from a rear plane to a forward peripheral edge of the shoe," we have carefully reviewed the specification but find no particular definition of "forward" plane. The specification on page 8 states that:

The lower surface 19 is further divided into a rear plane 27 and a forward plane 29. The wedge 15 increases in thickness forwardly from the rear peripheral edge 25 to where the rear plane 27 meets the forward plane 29, and remains substantially the same thickness from this location to the forward peripheral edge 21.

While this portion of the specification **describes** the forward plane as extending to peripheral edge 21 of the shoe, no particular **definition** of "forward plane" has been provided as the appellants would apparently have us believe.

Dependent claims 30 and 31 have not been separately argued with any reasonable degree of specificity and, accordingly, these claims fall with independent claim 1. **In re Nielson**, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987) and 37 CFR § 1.192(c)(7).

In view of the foregoing, we will sustain the rejection of claims 1, 30 and 31 under 35 U.S.C. § 102(e) as being anticipated by Fox.

Turning now to the rejections under 35 U.S.C. § 103(a) of claim 1 as being unpatentable over Whitaker in view of either Simoglou or Hackner and claims 28 and 29 as being unpatentable over Whitaker in view of either Simoglou or Hackner and further in view of Monier, both of these rejections are bottomed on the examiner's view that it would have been obvious to provide a rear planar surface on the shoe of Whitaker in view of the teachings of either Simoglou or Hackner. The main thrust of the appellants' position is that (a) Whitaker is directed to a protective attachment worn over shoes rather than to a shoe as claimed, (b) there is no teaching or suggestion to combine the teachings of the references in the manner proposed by the examiner and (c) the proposed combination would not

provide a substantially planar surface for supporting the sole of a wearer's foot as featured in Claim 1. The sole of a wearer's foot in the proposed combination would lie on [a] non-planar surface of a shoe of FIGURE 1. [Brief, page 10.]

Once again we are unpersuaded by the appellants' arguments. With respect to (a), the examiner has correctly noted that the footwear or shoe of Whitaker as depicted in Fig. 1 includes a sole 11 having a substantially planar upper

surface 6 and a substantially planar lower surface (unnumbered), and a shell or "upper" 5. Although it is true that the Whitaker's footwear or shoe is intended to fit over another shoe (1,2,3), there is simply no claim limitation which would preclude such an arrangement. As we have noted above, the claims in a pending application are to be given their broadest reasonable interpretations (***see In re Morris, supra***, and ***In re Zletz, supra***) and features not claimed may not be relied upon in support of patentability (***In re Self, supra***).

With respect to (b), the sole 11 of Whitaker has a constant thickness. Simoglou, however, discloses a sole having an inclined rear "plane" or ramp portion 20 (which, in conjunction with a substantially planar upper surface, provides an area of increasing thickness) for the purpose of aiding walking ability (see col. 2, line 29). Hackner discloses a similar arrangement at 5 in Fig. 1 for the purpose of bringing about "the desired stabilization of the foot" (translation, page 3). In our view, one of ordinary skill in this art would have found it obvious to provide the rear portion of the sole of Whitaker with an inclined rear plane in

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view of the teachings of either Simoglou or Hackner in order to achieve the advantages of aiding walking ability as taught by Simoglou or bringing about the stabilization of the foot as taught by Hackner.

With respect to (c), the appellants' contention is simply not commensurate in scope with the claimed subject matter. That is, independent claim 1 does not require that the sole of a wearer's foot be **directly** supported by the substantially planar upper surface as the appellants appear to argue. Rather, this claim more broadly requires that the sole of the shoe be "below" the sole of a wearer's foot "for supporting the sole [of a wearer's foot]." Viewing Fig. 1 of Whitaker, it is readily apparent that the substantially planar surface 6 is both below the sole of a wearer's foot and supports the sole of a wearer's foot (albeit indirectly via sole 2).

The appellants have not separately argued the patentability of dependent claims 28 and 29 with any reasonable degree of specificity. Accordingly, these claims fall with independent claim 1. *In re Nielson, supra*, and 37 CFR § 1.192(c)(7).

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In view of the above we will sustain the rejections under 35 U.S.C. § 103(a) of claim 1 based on the combined teachings of Whitaker and either Simoglou or Hackner and claims 28 and 29 based on the combined teachings of Whitaker, either Simoglou or Hackner, and Monier.

Considering next the rejection of claims 1 and 31 under 35 U.S.C. § 103(a) as being unpatentable over Whitaker in view of Fox, according to the examiner, it would have been obvious to "provide a rear surface as taught by Fox in the footwear device of Whitaker to increase exercise and stretching benefits to the wearer of the devices" (answer, page 5). We will not support the examiner's position. While Fox teaches a sole which increases exercise and stretching benefits to a wearer, Fox does so in the context of providing three distinct surfaces (i.e, an inclined front surface 26, a surface 29 of constant thickness and an inclined rear surface 30). That is, Fox teaches that all three surfaces are necessary in order to achieve the exercise and stretching benefits (see, generally, cols. 2, 3, 6 and 7). Absent the appellants' own disclosure, we are at a loss to understand why one of ordinary skill in the art would have been motivated to single out only the

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provision of an inclined rear surface and incorporate it into the shoe of Whitaker in the manner the examiner has proposed. The examiner may not pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. **See Bausch & Lomb, Inc., v. Barnes-Hind/Hydrocurve Inc.**, 796 F.2d 443, 448, 230 USPQ 416, 419 (Fed. Cir. 1986), **cert. denied**, 484 U.S. 823 (1987) and **In re Kamm**, 452 F.2d 1052, 1057, 172 USPQ 298, 301-02 (CCPA 1972). Accordingly, we will not sustain the rejection of claims 1 and 31 under 35 U.S.C. § 103(a) as being unpatentable over Whitaker in view of Fox.

Turning now to the various rejections of claims 32-34, we have carefully considered the subject matter defined by these claims. However, for reasons stated **infra** in our new rejections entered under the provisions of 37 CFR § 1.196(b), no reasonably definite meaning can be ascribed to certain language appearing in the claims. In comparing the claimed subject matter with the applied prior art, it is apparent to us that considerable speculations and assumptions are

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necessary in order to determine what in fact is being claimed. Since a rejection on prior art cannot be based on speculations and assumptions (**see *In re Steele***, 305 F.2d 859, 862-63, 134 USPQ 292, 295-96 (CCPA 1962) and ***In re Wilson***, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)), we are constrained to reverse the examiner's rejections of (1) claim 32 under 35 U.S.C. § 102(e) as being anticipated by Fox, (2) claims 32 and 33 under 35 U.S.C. § 103(a) as being unpatentable over Whitaker in view of either Simoglou or Hackner and (3) claims 33 and 34 under 35 U.S.C. § 103(a) as being unpatentable over Whitaker in view of Fox. We hasten to add that this is a procedural reversal rather than one based upon the merits of the §§ 102(e) and 103(a) rejections.

Under the provisions of 37 CFR § 1.196(b) we make the following new rejections:

Claims 32-34 are rejected under 35 U.S.C. § 112, first paragraph, as being based upon an original disclosure which fails to provide support for the invention now claimed. We initially observe that the description requirement found in the first paragraph of 35 U.S.C. § 112 is separate from the enablement requirement of that provision. ***See Vas-Cath, Inc.***

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v. Mahurkar, 935 F.2d 1555, 1560-64, 19 USPQ2d 1111, 1114-17
(Fed. Cir. 1991) and **In re Barker**, 559 F.2d 588, 591, 194 USPQ
470, 472 (CCPA 1977), **cert. denied**, 434 U.S. 1238 (1978).

With respect to the description requirement, the court in **Vas-
Cath, Inc. v. Mahurkar** at 935 F.2d 1563-64, 19 USPQ2d 1117
stated:

35 U.S.C. § 112, first paragraph, requires a
"written description of the invention" which is
separate and distinct from the enablement
requirement. The purpose of the "written
description" requirement is broader than to merely
explain how to "make and use"; the applicant must
also convey with reasonable clarity to those skilled
in the art that, as of the filing date sought, he or
she was in possession **of the invention**. The
invention is, for purposes of the "written
description" inquiry, **whatever is now claimed**.

. . . drawings alone **may** be sufficient to
provide the "written description of the invention"
required by § 112, first paragraph.

Here, the claims recite that the thickness of rear plane
(claim 32) or rear heel section (claim 33) is "less than the
substantially constant thickness" of the forward plane (claim
32) or forward toe section (claim 33). The appellants'
original disclosure, however, states that:

The lower surface 19 is further divided into a rear
plane 27 and a forward plane 29. The wedge 15
increases in thickness forwardly from the rear

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peripheral edge 25 to where the rear plane 27 meets the forward plane 29, and remains substantially the same thickness from this location to the forward peripheral edge 21. [Specification, page 8.]

It is thus readily apparent that according to the original disclosure the rear plane or rear heel section is of the **same thickness** at least where it meets the forward plane or forward toe section. See also Fig. 1 of the drawing as originally filed.

Claims 32-34 are rejected under 35 U.S.C. § 112, second paragraph. In order to satisfy the requirements of the second paragraph of § 112, a claim must accurately define the invention in the technical sense. **See In re Knowlton**, 481 F.2d 1357, 1366, 178 USPQ 486, 492-93 (CCPA 1973). In addition, while the claim language of claims 32-34 may appear, for the most part, to be understandable when read in the abstract, no claim may be read apart from and independent of the supporting disclosure on which it is based. **See In re Cohn**, 438 F.2d 989, 993, 169 USPQ 95, 98 (CCPA 1971).

Applying these principles to the present case, we are of the opinion that one of ordinary skill in this art would be at a loss to understand how the disclosed sole can be considered

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to have a rear plane or section which is of a thickness that is less than the substantially constant thickness of the forward plane or toe section inasmuch as, according to the specification (see page 8), they are of the **same thickness** at least where they meet. Thus, the language in these claims when read in light of the specification results in an inexplicable inconsistency that renders them indefinite.

In summary:

The rejection of claims 1, 30 and 31 under 35 U.S.C. § 102(e) as being anticipated by Fox is sustained.

The rejections under 35 U.S.C. § 103(a) of claim 1 based on the combined teachings of Whitaker and either Simoglou or Hackner and claims 28 and 29 based on the combined teachings of Whitaker, either Simoglou or Hackner, and Monier are sustained.

The rejection of claim 32 under 35 U.S.C. § 102(e) as being anticipated by Fox is reversed.

The rejections under 35 U.S.C. § 103(a) of claims 32 and 33 as being unpatentable over Whitaker in view of either Simoglou or Hackner and claims 1, 31, 33 and 34 as being unpatentable over Whitaker in view of Fox are reversed.

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In addition to affirming the examiner's rejection of one or more claims, this decision contains new grounds of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides, "A new ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellant may file a single request for rehearing within two months from the date of the original decision

37 CFR § 1.196(b) also provides that the appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

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(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

Should the appellants elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejections are overcome.

If the appellants elect prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejections, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

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AFFIRMED-IN-PART
37 CFR § 1.196(b)

	Ian A. Calvert)	
	Administrative Patent Judge)	
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	Harrison E. McCandlish, Senior)	BOARD OF
PATENT	Administrative Patent Judge)	APPEALS AND
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